

REMARKS

Claims 18-33 and 61-77 were pending at the time of the Office Action dated October 8, 2004. Claims 61-77 are canceled herein. Claims 18-33 are therefore now pending.

In the Office Action, the Examiner rejected claims 61-77 under 35 U.S.C. 101 as claiming the same invention as that of claims 26-42 of prior U.S. Patent No. 6,716,089 B2. Claims 18-33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,716,089 B2. Claims 18, 19, 21, 23 and 24 were rejected under 35 U.S.C. 102(e) as being anticipated by Bawa et al. (U.S. Patent No. 6,028,006). Claims 20, 22, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bawa et al. (U.S. Patent No. 6,028,006). Claims 26 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bawa et al. in view of Robinson (U.S. Patent No. 5,879,226). Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bawa et al. in view of Brunelli et al. (U.S. Patent No. 6,054,015).

Reconsideration of the invention is requested in light of the declaration under 37 C.F.R. § 1.131 submitted herewith and the following remarks.

With respect to the rejections on grounds of statutory double-patenting, claims 61-77 are canceled herein, which moots this ground of rejection.

With respect to the rejection on grounds of obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,716,089 B2, a Terminal Disclaimer is submitted herewith, which obviates this ground of rejection.

Turning to the rejections over the cited art, Applicants submit that each of these grounds of rejection are mooted by the declaration of one of the inventors, Judson Sharples, submitted herewith pursuant to § 1.131. More specifically, each of the grounds of rejection under §§ 102 and 103 are based on Bawa *et al.* as the primary reference. Bawa *et al.* was published on February 22, 2000, on an application filed August 1, 1997. The present continuation application claims priority to the parent application filed on July 23, 1998, which is prior to the publication of Bawa *et al.* Therefore, Bawa *et al.* would be prior art only under § 102(e). The enclosed declaration avers facts that show conception and diligence in actual reduction to practice of Applicants' invention prior to the filing date of Bawa *et al.* Accordingly,

Bawa *et al.* is not prior art under § 102(e) and therefore Applicants request withdrawal of each of the grounds of rejection under §§ 102 and 103 based on that reference.

In an Office Action for the parent of the present application, the Examiner objected to the same declaration because paragraph 3.4(b) of the accompanying Exhibit, which provided evidence of actual reduction to practice prior to the filing date of Bawa, also indicated that the invention had been put into production on a prior date, which is blacked out in the attached Exhibit. The Examiner stated the declaration was insufficient on those grounds.

As an initial matter, the undersigned disagrees with the Examiner's statement in the file history of the parent application that the declaration is not sufficient. The purpose of a declaration under § 1.131 is to swear behind a reference date by averring facts showing conception, and diligence in actual or constructive reduction to practice of the invention prior to the date of a reference. The present declaration avers such facts and is therefore sufficient for its intended purpose.

With respect to issues of prior disclosure in the Exhibit, which seemed to raise questions in the Examiner's mind regarding possible statutory bar events under 102(b), the undersigned respectfully submits that such questions do not go to the sufficiency of the declaration to swear behind the reference, but rather goes to other possible grounds of rejection. To address the Examiner's original concerns on these grounds, the same Exhibit filed with the originally filed declaration is again submitted herewith, but without the blacked-out "production" date. The undersigned notes that the date of first "production" of the invention was Sept 11, 1997. The parent application, to which the present application claim priority, was filed on July 23, 1998, which is less than one year before the first productive use of the invention. Accordingly, the earlier production of the invention is within the one year grace period provided under § 102(b) and therefore is not a statutory bar event under that section.

As for the disclosure to personnel outside the company mentioned in paragraph 3.3(c) of the Exhibit, the undersigned notes that such disclosure was solely for the purpose of having an outside manufacturer of a CMP machine provide appropriate plumbing to configure the machine on company premises so that the conceived method could be tested experimentally. Hence, this disclosure was not of the fully conceived invention, but only of certain plumbing requirements for the machine. Moreover, even if the inventive concept was disclosed at that

time, such disclosure would be as necessary to configure the machine for later experimental use on company premises to determine whether the inventive method would work. It has long been held that such experimental use is not public use within the meaning of section 102(b).

Accordingly, all of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:

Postcard
Check
Fee Transmittal Sheet (+ copy)
Terminal Disclaimer
Declaration Under 37 C.F.R. § 1.131
Exhibit A

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